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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,417

07/07/2003

Stephen L. Parkhurst

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7590

06/01/2006

EXAMINER

OH, SIMON J

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ART UNIT

PAPER NUMBER

1618

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/614,417	PARKHURST ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Simon J. Oh	1618	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Papers Received***

Receipt is acknowledged of the applicant's amendment and response, both received on 09 March 2006. Receipt is acknowledged of the applicant's terminal disclaimers, received on 18 May 2006 and 19 May 2006.

### ***Claim Rejections - 35 USC § 101 and 112***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claim 37 under 35 U.S.C. 112, second paragraph, as being indefinite is hereby withdrawn.

The rejection of Claim 37 under 35 U.S.C. 101 is hereby withdrawn.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for ALCOTEX®, FAVOR® SXM, HYSORB®, CARBOPOL ULTREX®, and A-140, does not reasonably provide enablement for other polymeric agents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Art Unit: 1618

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those in the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that one skilled in the art could not practice the invention without undue experimentation.

(1) The nature of the invention:

The invention provides for an odor-mitigating composition comprising a polymeric odor-mitigating reagent and methods of use thereof.

(2) The state of the prior art

Although compositions for the removal or neutralization of undesirable odors is well known in the art, the instant claims are drawn to odor removal systems using what has been described by the applicant as being “fundamentally new”. See Section 0005 of the instant specification.

(3) The relative skill of those in the art

The relative skill of those in the art is high.

Art Unit: 1618

(4) The predictability or unpredictability of the art

The unpredictability of the art high, as a broad range of 34 different functional groups for use in the polymeric material is disclosed in the instant specification. See Section 0034.

Moreover, certain embodiments call for the inclusion of both polymers containing Lewis acids and polymers containing Lewis bases, which are described by the applicant as being inherently incompatible. See Section 0060.

(5) The breadth of the claims

The claims are very broad. The claims are drawn to compositions polymeric odor-mitigating reagent having one or more functional groups drawn from a wide range of broad categories.

(6) The amount of direction or guidance presented

In the instant specification, the applicant provides some guidance through the use of specifically named polymers. However, the amount of guidance that is present does not appear to be sufficient to encompass every feasible sort of polymer that is encompassed by the scope of the instant claims.

(7) The presence or absence of working examples

Twenty-eight examples are given in the instant specification. However, these examples tend to be limited to the specifically named polymers listed above, such as ALCOTEX®, FAVOR® SXM, HYSORB®, CARBOPOL ULTREX®, and A-140. A polyacrylate polymer of

Art Unit: 1618

an unspecified nature is also included in some examples. None of the examples contain test data that demonstrate the particular effectiveness of each embodiment in terms of odor mitigation.

(8) The quantity of experimentation necessary

With the lack of extensive guidance from the prior art as well as from the instant specification, the types of materials for which the instantly claimed invention would be suitable cannot be reliably predicted a priori. When the above factors are weighed together, one of ordinary skill in the art would be burdened with undue “painstaking experimentation study” to determine the full range of suitable materials that are encompassed within the scope of the instant claims for each and every application envisioned by the applicant.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The rejection of Claims 1-46 under 35 U.S.C. 103(a) as being unpatentable over Piccini et al. is hereby withdrawn.

The rejection of Claims 1-46 under 35 U.S.C. 103(a) as being unpatentable over Piccini et al. (U.S. Patent No. 6,548,136) in view of Wang et al. (U.S. Patent Application Publication No. 2004/0254555) is hereby withdrawn.

Art Unit: 1618

***Response to Arguments***

Applicant's arguments filed 09 March 2006 have been fully considered but they are considered moot in view of the new grounds of rejection presented above.

***Correspondence***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Simon J. Oh whose telephone number is (571) 272-0599. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Simon J. Oh  
Examiner  
Art Unit 1618

sj0

  
MICHAEL G. HARTLEY  
SUPERVISORY PATENT EXAMINER